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IN THE

Supreme Court of the United States

OCTOBER TERM, 1952.

No. 118

LANOLIN PLUS COSMETICS, INC.,
Petitioner,

vs.

JOHN A. MARZALL, COMMISSIONER OF PATENTS,

and

BOTANY MILLS, INC.,
Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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No.

LANOLIN PLUS COSMETICS, INC.
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JOHN A. MARZALL, COMMISSIONER OF PATENTS,
and
BOTANY MILLS, INC.,
Respondents.

PETITION OF LANOLIN PLUS COSMETICS, INC. FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT.

TO THE HONORABLE THE CHIEF JUSTICE, AND THE ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioner, Lanolin Plus Cosmetics, Inc., respectfully prays for a writ of certiorari to the United States Court of Appeals for the District of Columbia Circuit to review the decision of that Court entered on April 17, 1952. A certified copy of the transcript of record including the decision in said Court is furnished herewith.

A SUMMARY AND SHORT STATEMENT OF THE MATTER INVOLVED.

Petitioner is seeking to obtain registration of the combination of words LANOLIN PLUS as a trade mark for cosmetics and soap. Petitioner has disclaimed any right to the word lanolin alone.

Petitioner coined the expression LANOLIN PLUS as a new, unique and original combination. In order to obtain registration of its trade mark, petitioner duly filed applications under the Trade Mark Act of 1905. The Examiner of Trade Marks considered LANOLIN PLUS not to be descriptive and allowed the applications. Oppositions were then filed by respondent Botany Mills, Inc., claiming that LANOLIN PLUS should be denied registration as descriptive.

LANOLIN PLUS is a clever play on words and is designed to appeal to feminine fancy. It has attracted attention and incited sales by its unusual approach. Petitioner's LANOLIN PLUS cosmetics and soap are on sale in Washington, D.C. and throughout the country, in practically every drug and department store. Sales of LANOLIN PLUS cosmetics now exceed one million dollars annually.

For more than fifty years, the Patent Office has consistently and repeatedly held that a generic word like LANOLIN, followed by the word PLUS, is not descriptive and is registrable. There are 129 registrations of such combinations which have been granted in a consistent policy of holding such combinations non-descriptive under the Act of 1905. For example, VITAMINS PLUS, SILK PLUS, OIL PLUS and ASPIRIN PLUS have all been granted registration. Yet petitioner alone has been denied registration of an identical type of trade mark.

The Patent Office even today is following its 129 precedents and currently registering PLUS marks to others, but not to petitioner. It is absurd to say that the Patent Office made 129 successive and consistent mistakes. When PLUS marks are allowed over a hundred times for a period of fifty years, how can any one argue that this trend, this policy is an isolated error? For over fifty

years, the Patent Office has not cancelled a single PLUS registration. On the contrary, it has allowed all of them, except the LANOLIN PLUS trade mark of plaintiff.

This clearly shows unfair and arbitrary discrimination against appellant. Out of 130 applications for registration of trade marks of this kind, 129 have been allowed and only appellant has been denied registration.

Petitioner appeals to this Court as a court of equity to grant relief against the action taken by the Commissioner and the courts. It is believed that the record establishes a clear and firm basis for the granting of relief in the form of an order requiring the Commissioner of Patents to grant petitioner's trade mark the same protection under the law which has been granted to all similar trade marks, and therefore grant the registrations of LANOLIN PLUS to petitioner.

JURISDICTION.

This suit was filed in the United States District Court for the District of Columbia under Section 4915 of the Revised Statutes of the United States. (U.S.C. Title 35, Section 63)

The basis upon which it is contended that this Court has jurisdiction to review the decision of April 17, 1952, of the United States Court of Appeals for the District of Columbia Circuit is as follows: Section 18 of the Trade Mark Act of 1905, U.S.C. Title 15, Sec. 98; 28 U.S.C.A. 1254; United States Constitution, and amendments.

THE QUESTIONS PRESENTED.

1. Was the action of the Commissioner of Patents and the Courts in denying petitioner's registration of the

trade mark LANOLIN PLUS arbitrary and unfairly discriminatory in view of the granting of registration of more than 129 trade marks of the same type to others both before and after the denial of petitioner's registration?

2. Did the action of the Commissioner of Patents and the Courts constitute a clear abuse of administrative and judicial discretion?

3. Does the doctrine of equal protection of the laws under the Constitution of the United States apply to the executive and judicial branches of the federal government as well as to the states?

4. Did the denial of petitioner's registration constitute a deprival of property without due process of law and a denial of equal protection of the laws under the Constition of the United States?

5. Was the action of the Commissioner of Patents and the Courts based upon an error of law in denying petitioner's registration when the only opposing party had never used petitioner's trade mark and had no right to use or register petitioner's trade mark?

6. Was the action of the Court of Appeals for the District of Columbia arbitrary and discriminatory in view of its admission that "Appellant appears to be right in its contention that a number of similar trade marks which the Patent Office has registered are equally descriptive"?

7. Is petitioner entitled to equal justice under the law?

THE REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT.

1. The Court of Appeals for the District of Columbia has not given proper effect to the applicable decision

of this Court in the case of *Beckwith* v. *Commissioner of Patents*, 252 U.S. 538.

2. The Court of Appeals for the District of Columbia has decided questions of substance relating to the construction or application of the Constitution of the United States which have not been, but should be, settled by this Court.

3. The Court of Appeals for the District of Columbia has decided a question of general and public importance relating to the registration of trade marks under the federal statutes.

4. The actions of the Commissioner of Patents and the Courts herein were arbitrary and unfairly discriminatory to petitioner and deprived petitioner of equal protection of the laws and equal justice under the law and deprived petitioner of property without due process of law, in violation of the Fifth Amendment of the Constitution.

Petitioner sets forth its argument in the brief that follows.

Wherefore it is requested that this Court grant this petition.

Respectfully submitted,

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BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

THE ACTION OF THE COMMISSIONER OF PATENTS AND THE COURTS WAS CLEARLY ARBITRARY AND DISCRIMINATORY AND SHOULD BE REVERSED.

This is a case in which the petitioner seeks registration of the trade mark LANOLIN PLUS for cosmetics and toliet preparations. Petitioner does not claim the exclusive use of lanolin alone, but only of the original and fanciful combination trade mark LANOLIN PLUS.

Ever since the Trade Mark Act of 1905 was passed, the Commissioner of Patents has allowed registrations of trade marks similar to LANOLIN PLUS. The record shows that the following trade marks have been granted registration under the Act of 1905, the same law under which petitioner seeks registration of its trade mark:

Vitamins Plus	Oil Plus
Aspirin Plus	Milk Plus
Safety Plus	Style Plus
Sweet Plus	Silk Plus
Mileage Plus	Seal Plus

Petitioner placed in evidence copies of 129 registrations of trade marks of the type substantially identical with its trade mark LANOLIN PLUS, all of which have been allowed by the Commissioner of Patents under the Act of 1905. Despite this evidence, petitioner's applications for registration of its trade mark LANOLIN PLUS were denied by the Commissioner of Patents and the Courts.

It is well established that an administrative or judicial action may be reversed by the courts where such action is shown to be arbitrary or unfairly discriminatory.

In the case of *Johnson* v. *Towsley,* 80 U.S. 68, this Court held that:

> "There has always existed in the courts of equity the power in certain classes of cases to inquire into and correct mistakes, injustice, and wrong in both judicial and executive action."

This Court held in the case of *Butterworth* v. *United States,* 112 U.S. 50, that a review of the action of the Commissioner of Patents in a case of this kind should be a trial *de novo.* This Court held with regard to Section 4915:

> "It is not a technical appeal from the Patent Office, like that created in Section 4911, confined to the case as made in the record of that office, but is prepared and heard upon all competent evidence adduced and upon the whole merits. Such has been the uniform and correct practice in the circuit courts."

In the case at bar, petitioner is the owner of a valuable trade mark. It sought registration of its trade mark in the Patent Office in the manner prescribed by law. The Commissioner of Patents has previously granted registration of 129 trade marks of the same type. But in this case, and in this case alone, the Commissioner of Patents denied this registration. Out of 130 applications for registration of trade marks of this kind, 129 have been allowed and only petitioner has been denied registration.

Petitioner submits that nothing could be more discriminatory, more unfair and more arbitrary than to deny petitioner the same protection under the statute that has previously been granted to other trade mark owners.

It is believed that the granting of registration of such trade marks as VITAMINS PLUS for vitamins, ASPIRIN PLUS for aspirin, MILK PLUS for milk, OIL PLUS for oil and all of the other trade marks which have been granted ever since the passage of the Trade Mark Act of 1905 constitutes a clear and firmly established

administrative policy. These registrations have been granted one after the other, year after year, and no trade mark of this kind was ever denied registration.

Yet when petitioner's applications were filed, petitioner was denied the same protection under the trade mark statute which had previously been granted to everyone else in the same position as petitioner.

Was this a change in administrative policy? It was not, because the Commissioner of Patents has allowed registrations of the same type to others on applications filed *after* those of petitioner.

The Official Gazette of the Patent Office for November 6, 1951, showed on page 24 the allowance by the Commissioner of Patents of an application for registration of the trade mark BOND-PLUS. Again, on December 25, 1951, the Commissioner of Patents allowed and published the trade mark MISTER PLUS. Both of these applications were filed and allowed **after** petitioner's applications had been filed and **after** petitioner's applications had been denied.

This is clear discrimination. It is an arbitrary and unfair distinction, drawn between petitioner on the one hand and all other trade mark owners on the other hand.

Petitioner submits that an arbitrary and unfairly discriminatory action of this kind should be reviewed and reversed by this Court. The action of the Commissioner of Patents (and the Courts in upholding him) has deprived petitioner of the same protection under the trade mark statute which had previously and subsequently been granted to everyone else.

The record further shows that petitioner has been granted registration of its trade mark LANOLIN PLUS

in every one of the 48 states of the United States and in Hawaii and Puerto Rico. Thus, the administrative agencies of every state have recognized petitioner's property right in its trade mark LANOLIN PLUS. All 48 states have granted petitioner registration of its trade mark, showing that all of them regard LANOLIN PLUS as a good, valid and registrable trade mark.

PETITIONER HAS BEEN DEPRIVED OF PROPERTY WITHOUT DUE PROCESS OF LAW.

The trade mark LANOLIN PLUS is a property right of great value to petitioner. Petitioner's entire business in the manufacture and sale of cosmetic preparations is built around the trade mark LANOLIN PLUS and the good will relating thereto. The sale of cosmetics under petitioners trade mark LANOLIN PLUS now exceeds $1,000,000.00 a year, so that petitioner's rights in this trade mark are its most substantial business asset.

In the case of *Chattanooga Foundry and Pipe Works* v. *Atlanta,* 203 U.S. 390, Mr. Justice Holmes of this Court said that:

> "A trade mark, or a trade name, or a title, is property, and is regarded as an object capable of injury in various ways."

In the case of *Beckwith* v. *Commissioner of Patents,* 252 U.S. 538, this Court held that:

> "Of course, refusal to register a mark does not prevent a former user from continuing its use, but it deprives him of the benefits of the statute, and this should not be done if it can be avoided by a fair, even liberal, construction of the Act, designed as it is to promote the domestic and foreign trade of our country."

In *Lynch* v. *United States,* 292 U.S. 571, this Court held that an Act of Congress which revoked the right

to enforce a contract by legal process was a violation of the due process clause of the Fifth Amendment. Mr. Justice Brandeis, speaking for the Court, said:

> "Contracts between individuals or corporations are impaired within the meaning of the Constitution whenever the right to enforce them by legal process is taken away or materially lessened."

In the present case, petitioner's right to enforce its trade mark rights has been materially lessened by the refusal of the Commissioner of Patents to grant registration of its trade mark. A trade mark is only as good as the protection which it receives under the law. By denying petitioner's trade mark such protection, the Commissioner of Patents has taken from petitioner a property right of substantial value.

Petitioner submits that since the action of the Commissioner of Patents has clearly been shown to be unfair, discriminatory and arbitrary, the denial of registration of petitioner's trade mark deprives petitioner of a substantial property right without due process of law, in violation of the Fifth Amendment of the Constitution of the United States. *Lynch* v. *United States,* 292 U.S. 571; *Myles Salt Co.* v. *Board of Commissioners,* 239 U.S. 478; *Johnson* v. *Towsley,* 80 U.S. 68; *Miss. R.R. Commission* v. *Mobile & Ohio R.R.,* 244 U.S. 388; *Washington* v. *Roberge,* 278 U.S. 116.

Petitioner submits that this contitutional question should be heard and decided by this Court, to protect the property rights of petitioner.

PETITIONER'S TRADE MARK IS NOT DESCRIPTIVE AND SHOULD BE GRANTED REGISTRATION UNDER THE TRADE MARK ACT OF 1905.

Petitioner submits that its trade mark LANOLIN PLUS is not "merely descriptive" of cosmetics and that

its mark should be granted registration under the Trade Mark Act of 1905.

Petitioner's trade mark consists of the fanciful combination of words LANOLIN PLUS. The only word in petitioner's trade mark which is descriptive is the word lanolin. The word PLUS certainly does not describe cosmetics or any quality or characteristic of such goods.

This Court had before it in the case of *Beckwith* v. *Commissioner of Patents,* 252 U.S. 538, the question of what should be done when only part of a trade mark is descriptive. The Court held that if a disclaimer were made of the descriptive part of the mark, the registration should be granted. The Court said that:

> "The commercial impression of a trade mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason, it should be considered in its entirety and to strike out any considerable part of it, certainly any conspicuous part of it, would be to greatly affect its value."

The Court held that such a disclaimer would protect others in their right to use the merely descriptive part of the mark, saying that:

> "It seems obvious that no one could be deceived as to the scope of such a mark, and that the registrant would be precluded by his disclaimer from setting up in the future any exclusive right to the disclaimed part of it."

In this case, petitioner has already filed a disclaimer of the descriptive word lanolin. Since the word PLUS alone or in combination with lanolin does not describe cosmetics, there is no basis for the denial of petitioner's registration under the ruling of this Court.

The statute clearly provides that registration shall be refused only where the mark is "merely descriptive". This Court has held that registration must be granted in all other cases, including those in which only a part of the mark is descriptive and that part has been disclaimed. This Court held that "the language of the statute that no mark not within its prohibitions or provisos shall be denied registration is just as imperative as the prohibitory words of the proviso."

Petitioner submits that the action of the Commissioner of Patents and the Courts in this case is in clear conflict with the applicable decisions of this Court. It is contrary to the above ruling and also contrary to the decision of this Court in *Hamilton-Brown Shoe Co.* v. *Wolf Bros. & Co.*, 240 U. S. 251, where this Court held:

> "We do not regard the words 'The American Girl' adopted and employed by complainant in connection with shoes of its manufacture as being a geographical or descriptive term. * * * Indeed, it does not, in its primary signification, indicate shoes at all. It is a fanciful designation, arbitrarily selected by complainant's predecessors to designate shoes of their manufacture."

In the case of *Menendez* v. *Holt*, 128 U. S. 520, this Court held that the trade mark LA FAVORITA was not descriptive of flour, saying that:

> "And the fact that flour so marked has acquired an extensive sale, because the public had discovered that it might be relied on as of a uniformly meritorious quality **demonstrates that the brand deserves protection** rather than that it should be debarred therefrom, on the ground, as argued, of being indicative of quality." (Emphasis ours.)

THE RULING OF THE COMMISSIONER OF PATENTS WAS BASED ON AN ERROR OF LAW.

It is well established that an administrative or judicial action is subject to review and reversal where it is based on an error of law. *Gegiow* v. *Uhl*, 239 U. S. 3; *Ng Fung Ho* v. *White*, 259 U. S. 276.

In this case, the Commissioner of Patents and the Courts denied petitioner's registration of its trade mark LANOLIN PLUS on the basis of an opposition proceeding which was instituted by respondent Botany Mills, Inc. It is an undisputed fact that Botany Mills, Inc. has never used the trade mark LANOLIN PLUS, does not intend to use it, and does not claim the right to use or register LANOLIN PLUS.

On the basis of such a showing, the Commissioner of Patents held that Botany Mills, Inc. would be damaged by the granting of petitioner's registration. How would it be damaged? The granting of petitioner's registration would not in any way interfere with respondent's use of the word lanolin, since petitioner has disclaimed the word lanolin.

Respondent Botany Mills, Inc. admitted that it owns no trade mark rights in the word lanolin, all of its goods being sold under the trade mark BOTANY. It has admitted that no one would think of any product as respondent's unless it bore the trade mark BOTANY.

The opposition proceeding could not be sustained on the basis of respondent's prior trade mark rights in LANOLIN PLUS, since respondent admitted that it had no trade mark rights to the term LANOLIN PLUS or any part thereof.

Petitioner submits that the sustaining of the opposition on the ground that respondent Botany Mills, Inc. would be damaged by the granting of petitioner's registration was a clear error of law. Respondent Botany Mills, Inc. had no right, as a matter of law, to oppose the granting of petitioner's registration, since it had and claimed to have no prior rights or rights of any kind to petitioner's trade mark LANOLIN PLUS.

PETITIONER IS ENTITLED TO EQUAL JUSTICE UNDER THE LAW AND TO EQUAL PROTECTION OF THE LAWS.

It is a fundamental principle of American justice and of any system of justice which is not a mockery of the term that every person is entitled to equal protection of the laws and to equal justice under the law.

Above the portals of the building which houses the Supreme Court of the United States is inscribed the legend "Equal Justice Under Law".

The doctrine of equal justice and equal protection of the laws is a fundamental part of our Constitution and our system of government. It is but one manifestation of the pronouncement in the Declaration of Independence that "All men are created free and equal."

It is believed that the doctrine of equal justice and equal protection under the law is a fundamental right which is granted to everyone and which applies to the executive and judicial branches of the federal government as well as to the states.

The action of the Commissioner of Patents and the Courts in this case clearly deprived petitioner of its fundamental right to equal justice under the law. The law protects the trade mark of everyone except petitioner.

It is believed that petitioner's right to equality and justice should be upheld by this Court against the arbitrary and unfairly discriminatory actions of the Commissioner of Patents and the Courts.

Petitioner submits that its petition for writ of certiorari should be granted.

Respectfully submitted,

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In the Supreme Court of the United States

OCTOBER TERM, 1952

No. 118

LANOLIN PLUS COSMETICS, INC., PETITIONER

v.

JOHN A. MARZALL, COMMISSIONER OF PATENTS, AND BOTANY MILLS, INC.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF IN OPPOSITION FOR THE RESPONDENT COMMISSIONER OF PATENTS

OPINIONS BELOW

The findings of fact, conclusions of law and opinion of the District Court for the District of Columbia (R. 12-14) are not reported. The *per curiam* opinion of the Court of Appeals (R. 44-45) is reported at 196 F. 2d 591.

JURISDICTION

The judgment of the Court of Appeals was entered on April 17, 1952 (R. 46). The petition for a writ of certiorari was filed on June 10, 1952. The

jurisdiction of this Court is invoked under 28 U. S. C. 1254(1).[1]

QUESTIONS PRESENTED

1. Whether petitioner is entitled to the registration in the Patent Office of a trade-mark which is merely descriptive of the quality of an ingredient of the goods for which it is used.

2. Whether petitioner is entitled to the registration of a trademark, the registration of which is expressly forbidden by law, on the ground that similar marks have been registered in the Patent Office.

STATUTE INVOLVED

Section 5 of the Trade Mark Act of 1905, 33 Stat. 724, 725-6, 15 U. S. C. 85(b), provides in pertinent part as follows:

> No mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—
>
> (b) * * * Provided, That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the

[1] Section 18 of the Trade-Mark Act of 1905, 33 Stat. 724, 729, 15 U.S.C. 98, also relied on by petitioner, was repealed by Section 39 of the Act of June 25, 1948, 62 Stat. 869, 992.

character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act * * *.

STATEMENT

Disclaiming any right to the word lanolin alone (R. 32, 33), petitioner applied for registration of the combination "Lanolin Plus" as a trade-mark for cosmetics and soap under the Trade Mark Act of 1905. Respondent Botany Mills, Inc., filed oppositions on the ground that the term "Lanolin Plus" was descriptive. The Examiner of Interferences first sustained Botany Mills' opposition to registration of "Lanolin Plus" for face cream and related products on July 28, 1947 (R. 32) and this decision was affirmed by the Assistant Commissioner on March 16, 1948 (R. 33). A different Examiner of Interferences sustained the opposition to the registration for soap on March 15, 1950 (R. 37-39) and was in turn affirmed by a different Assistant Commissioner of Patents (R. 40). Petitioner then instituted a proceeding in the United States District Court for the District of Columbia under R. S. 4915, 35 U. S. C. 63 (R. 1-10). The District Court agreed with the Patent Office that the words "Lanolin Plus" were descriptive and not entitled to registration as a trade-mark (R. 12). The Court of Appeals affirmed (R. 44-45).

ARGUMENT

1. Section 5(b) of the Trade-Mark Act of 1905, *supra,* expressly forbids the registration of a trade-mark which is merely descriptive of the

goods with which it is used. In the instant case, the Examiners of Interferences (R. 32-33, 37-39), the Assistant Commissioners of the Patent Office (R. 33-36, 40-42), and the District Court (R. 13) all found that the mark "Lanolin Plus" is merely descriptive for cosmetics and soaps, and rejected petitioner's contention that the term is fanciful. These findings, which were implicitly accepted by the court below (R. 44-45), are plainly correct. Manifestly, lanolin describes the ingredient and "plus" is an enthusiastic term descriptive of purity, quality or efficacy (R. 23-24, 26-30). In the words of the Assistant Commissioner, it indicates that "the goods contain a superior grade of lanolin * * * a mere laudatory expression" (R. 35). Cf. *Burmel Handkerchief Corp.* v. *Cluett, Peabody & Co.*, 127 F. 2d 318 (C.C.P.A.); *Franklin Knitting Mills* v. *Fashionit Sweater Mills*, 297 Fed. 247 (S.D.N.Y.), affirmed, 4 F. 2d 1018 (C.A. 2).

The decisions below denying registration of petitioner's mark [2] are supported by the holdings of this Court, which establish that under the 1905 Act no one can preempt descriptive terms and thereby gain a monopoly to fence out competitors who have equal rights to sell the products. *Warner & Co.* v. *Lilly & Co.*, 265 U. S. 526, 528; *Standard Paint Co.* v. *Trinidad Asphalt Co.*, 220 U. S. 446, 453;

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[2] As the Court of Appeals noted (R. 45, fn. 1), Section 2(e) of the Trade-Mark Act of 1946, 60 Stat. 429, 15 U.S.C. 1052(e), is not applicable to a proceeding pending before the Patent Office before July 5, 1947. Act of July 5, 1946, Sec. 46(a), 60 Stat. 444; see also *Magic Foam Sales Corp.* v. *Mystic Foam Corp.*, 167 F. 2d 88, 90 (C.A. 6).

Elgin Nat'l Watch Co. v. *Illinois Watch Case Co.*, 179 U. S. 665, 673; *Canal Co.* v. *Clark*, 13 Wall. 311, 323. The Patent Office represents the public interest (*Tomlinson of High Point* v. *Coe*, 123 F. 2d 65 (C.A. D.C.); *Ippolito* v. *Nancy Ann Dressed Dolls*, 184 F. 2d 201, 203 (C.C.P.A.)) and that interest, as declared by Congress in the statute, precludes the registration of a descriptive mark. There is no semblance to the arbitrary or fanciful (see *Hamilton Shoe Co.* v. *Wolf Brothers*, 240 U. S. 251, 256) in the term "Lanolin Plus", as applied to cosmetics and soap with lanolin as an ingredient (R. 18). It is neither suggestive nor figurative. See *General Shoe Corp.* v. *Rosen*, 111 F. 2d 95, 98 (C. A. 4).

At the outset of a promotional campaign, "Lanolin Plus" would hardly signify the producer rather than the product, its qualities, ingredients, and characteristics. *Kellogg Co.* v. *Nat. Biscuit Co.*, 305 U. S. 111, 118; *Beckwith* v. *Commissioner of Patents*, 252 U. S. 538, 543. To register the mark would encourage the misconception that others have no right to sell lanolin cosmetics and soaps. *Singer M'f'g Co.* v. *June M'f'g Co.*, 163 U. S. 169, 185-186; *United Shoe Mach. Corp.* v. *Compo Shoe Mach. Corp.*, 56 F. 2d 292 (C. C. P. A.). But petitioner has no exclusive right to sell lanolin products. See *Durable Toy & Novelty Corp.* v. *J. Chein & Co.*, 133 F. 2d 853, 854 (C. A. 2), certiorari denied, 320 U. S. 211. A mark will not be registered if the courts would decline to protect it. *Mont-O-Min Sales Corporation* v. *Wyeth, Incorporated*, 92 F.

Supp. 150, 155 (W. D. Mo.). And "no sign or form of words can be appropriated as a valid trade mark, which from the nature of the fact conveyed by its primary meaning, others may employ with equal truth, and with equal right, for the same purpose." *Elgin Nat'l Watch Co.* v. *Illinois Watch Case Co.,* 179 U. S. 665, 673; see also *Standard Paint Co.* v. *Trinidad Asph. Co.,* 220 U. S. 446, 453; *Canal Company* v. *Clark,* 13 Wall. 311, 323. A descriptive word cannot form the dominant part of a mark. *National Nugrape Co.* v. *Judge & Dolph,* 154 F. 2d 521 (C.C.P.A.); *West Disinfecting Co.* v. *Lan-O-Sheen Co.,* 163 F. 2d 566, 569 (C.C.P.A.). No prior course of conduct in the Patent Office recognizing "plus" combinations would justify a deviation from the statutory prohibition against registration of descriptive marks. *Application of National Recreation Ass'n,* 181 F. 2d 221 (C.C.P.A.); cf. *Houghton* v. *Payne,* 194 U. S. 88, 100; *Schafer* v. *Helvering,* 83 F. 2d 317, 320 (C.A. D.C.), affirmed, 299 U. S. 171.

Petitioner's claim that it was entitled to registration of its trade-mark because the Patent Office has registered a number of similar marks was properly disposed of by the court below in its observation (R. 45):

> But the fact that the [Patent] Office has erred in those instances does not mean that it should err in this one.

In view of the fact that the statute expressly forbids the registration of marks that are merely de-

scriptive, it may be reasonably assumed that the Patent Office, in the prior matters mentioned by petitioner, reached factual determinations that the marks there considered were not merely descriptive of the goods involved. Those factual determinations would clearly not bind the Patent Office to make similar determinations in future cases involving different marks and different goods. Nor would those factual determinations amount to an administrative interpretation of the statute that descriptive marks may be registered. The express prohibition of the statute against the registration of descriptive marks, together with the public policy against the fostering of monopoly, would render clearly erroneous any administrative interpretation authorizing the registration of such marks and leave it entitled to no weight whatever. Moreover, in situations where the standards for applying trade-mark statutes set up by the Patent Office are later determined by it to be broader than the statutes reasonably permit, the courts will uphold the decisions of that Office in correctly revising those standards. *White House Milk Products Co.* v. *Dwinell-Wright Co.*, 111 F. 2d 490, 492-493 (C.C.P.A.); *Application of National Recreation Ass'n*, 181 F. 2d 221, 222 (C.C.P.A.). And this Court will decline to apply an unreasonably broad interpretation of a patent statute by that Office. *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147. Thus, petitioner has no vested right to have the Patent Office follow its prior determinations.

2. Petitioner contends that the refusal of the

Patent Office to register its trade-mark deprived it of its property without due process of law (Br. 9), and denied it the equal protection of the laws (Br. 14). These contentions are patently without substance. Petitioner is entitled to the privilege of registration only if Congress has authorized it (Cf. *Houghton* v. *Payne*, 194 U. S. 88, 100). Here, Congress has expressly forbidden the registration of a trade-mark such as petitioner's which is merely descriptive of the goods with which it is used. Moreover, even if Congress had permitted registration of a trade-mark such as that here involved, it would confer no substantive right on petitioner, but only a procedural advantage. See *Armstrong Co.* v. *Nu-Enamel Corp.*, 305 U. S. 315, 322; *Best & Co.* v. *Miller*, 167 F. 2d 374, 376 (C. A. 2), certiorari denied, 335 U. S. 818. Hence, it is difficult to see how the failure of the Patent Office to register the trade-mark could deprive petitioner of property or property rights. The equal-protection-of-the-laws clause of the Fourteenth Amendment does not, of course, apply to the Federal Government,[3] and there is obviously no such discriminatory treatment as could possibly ground a claim of denial of due process, even if that clause of the Fifth Amendment were otherwise applicable.[4]

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[3] *Hirabayashi* v. *United States*, 320 U.S. 81, 100; *Detroit Bank* v. *United States*, 317 U.S. 329, 331; *Sunshine Coal Co.* v. *Adkins*, 310 U.S. 381, 401; *Currin* v. *Wallace*, 306 U.S. 1, 14; *Steward Machine Co.* v. *Davis*, 301 U.S. 548, 584; *Truax* v. *Corrigan*, 257 U.S. 312, 332.

[4] The ruling of the court below does not estop petitioner from seeking registration of its mark under Section 1(b) of the Act of March 19, 1920 (41 Stat. 533), which provided for the

CONCLUSION

Petitioner's mark, which merely specifies an ingredient and adds a laudatory suffix, is plainly not entitled to registration. The decision of the court below is clearly correct, and further review is not warranted. It is respectfully submitted, therefore, that the petition for a writ of certiorari should be denied.

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JULY, 1952.

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registration of marks not registrable under the proviso of Section 5 of the 1905 Act, and "which have been in bona fide use for not less than one year in interstate or foreign commerce." *Cf. Armstrong Co.* v. *Nu-Enamel Corp.*, 305 U.S. 315.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1952.

No. 118.

LANOLIN PLUS COSMETICS, INC., *Petitioner,*

v.

JOHN A. MARZALL, COMMISSIONER OF PATENTS,

and

BOTANY MILLS, INC., *Respondents.*

On Petition for Writ of Certiorari to the United States Court of Appeals for the District of Columbia Circuit

BRIEF FOR THE RESPONDENT, BOTANY MILLS, INC. IN OPPOSITION

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BRIEF FOR THE RESPONDENT, BOTANY MILLS, INC. IN OPPOSITION

Opinions Below

The opinion of the District Court (R. 12-14) dismissing petitioner's complaint, has not been officially reported. The opinion of the United States Court of Appeals for the District of Columbia Circuit (R. 44) is reported at 196 F. 2d 591 (1952).

Jurisdiction

The judgment of the United States Court of Appeals was entered on April 17, 1952 (R. 46). The petition for writ of certiorari was filed on June 10, 1952, and it was served

on respondent, Botany Mills, Inc., on June 18, 1952. The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code, as amended by the Act of February 13, 1925.

Question Presented

The question presented is whether the notation LANOLIN PLUS is registrable as a trademark for cosmetics and soaps under the Trade-Mark Act of February 20, 1905.

Statute Involved

Section 5 of the Trade-Mark Act of 1905 (Act of February 20, 1905, c. 592, 33 Stat. 724; 15 U. S. C. § 85) provides in part that no trade-mark which consists . . .

> "merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, . . . shall be registered under the terms of this act;"

Statement

Petitioner sought registrations in the United States Patent Office of the notation LANOLIN PLUS under the Trade-Mark Act of 1905, as a trade-mark for face cream and related products, as well as for toilet soap and laundry soap. Exclusive rights to the word "lanolin" were disclaimed in both applications. Oppositions to these applications were filed by respondent, Botany Mills, Inc., based upon the ground that the notation LANOLIN PLUS was not registrable under the Act of 1905 in view of its completely descriptive character. It was alleged that Botany Mills, Inc. and others similarly situated would suffer injury in their business if so descriptive a notation as LANOLIN PLUS could be exclusively appropriated by a competitor in the cosmetic business. The Examiner of Interferences of the Patent Office sustained both Opposition No. 24,963, with regard to face cream, and Opposition No. 26,917, with regard to soap (R. 32 and 37). The Examiner held the notation

LANOLIN PLUS to be incapable of exclusive appropriation under Section 5 of the Act of 1905.

On appeal, the Commissioner of Patents sustained the Examiner's decisions on the same ground. (R. 33 and 40)

Petitioner thereupon brought this suit in the United States District Court for the District of Columbia, under Section 4915 of the Revised Statutes, as amended (35 U. S. C. § 63), asking that the respondent, the Commissioner of Patents, be directed to issue to petitioner certificates of registration of its trade-mark, which, the complaint alleged, respondent had refused. (R. 1) After a trial, the District Court dismissed the complaint (R. 12), finding as facts that petitioner's mark was "clearly descriptive" and, therefore, not entitled to registration. The District Court held that, notwithstanding the previous grant of certain similar trademark registrations to other parties the notation LANOLIN PLUS did not qualify for registration, and that the other registrations relied upon by petitioner could not "overcome the language of the statute". (R. 12)

The court below affirmed the judgment of the District Court in a *per curiam* decision. (R. 44) It emphasized that the fact that the Patent Office may have erred in earlier cases "does not mean it should err in this one". (R. 45) Consequently, the court below unanimously reached the conclusion that the decision of the District Court should be affirmed.

Argument

Petitioner's applications to register the notation LANOLIN PLUS under the Act of 1905 have now been rejected by four different tribunals without a single dissent and always on the identical statutory ground. This is probably the first time in the history of this Court that an applicant for registration of a trade-mark has gone so far as to invoke the "equal protection" clause of the Federal Constitution (Petition for Certiorari, p. 4) and the "due process" clause of the Constitution (ibid.), for the purpose of determining the simple statutory question whether the notation LANOLIN

PLUS is "descriptive" as applied to face cream and soap. That the determination of the registrability of a descriptive term does not involve a constitutional problem or any problem of a federal nature which should be settled by this Court, appears so obvious on its face as to require hardly any further discussion in this brief.

I. The proceeding under Revised Statutes 4915, which petitioner instituted after both the Examiner of Interferences and the Commissioner of Patents had rejected the notation LANOLIN PLUS as being clearly descriptive, is not in the nature of an appeal but is a *de novo* proceeding in the nature of an action to set aside a judgment. It is settled beyond dispute that in such a proceeding an administrative ruling should not be set aside, unless found to be clearly erroneous. As stated by this Court, in *Morgan* v. *Daniels*, 153 U. S. 120 (1894), a proceeding under R. S. 4915 in a patent or trade-mark case "is something more than a mere appeal". The Patent Office ruling will not be set aside, under the *Morgan* doctrine, unless upon the presentation of testimony "which in character and amount carries thorough conviction". The same basic principle was recently applied in *Safeway Stores, Inc.* v. *Dunnell*, 172 F. 2d 649 (9th Cir. 1949).

There is nothing in the record or in the petition for certiorari to indicate that the Patent Office tribunals, the District Court, and the Court of Appeals in its *per curiam* decision have all misconstrued the federal trade-mark statute by coming to the obviously correct and common-sense conclusion that the generic word "lanolin" cannot be converted into an exclusive trade-mark by adding the descriptive word "plus" thereto.

II. The argument submitted by the petitioner to this Court is in effect an accusation that the Patent Office tribunals, as well as both lower courts, have violated the 5th Amendment of the Constitution by refusing to continue an alleged erroneous practice of the past. Actually, there are

not more than about five or six previous "Plus" marks registered which correspond to the one now before the Court, such as, for instance, "VITAMIN-PLUS", "ASPIRIN-PLUS", and a few others. A superficial glance at the 129 so-called "plus" registrations submitted by petitioner to the trial court will show that the vast majority thereof disclose arbitrary features in addition to the word "-PLUS", which made the respective marks registrable under the Act of 1905.

Moreover, the Commissioner of Patents has frequently changed his position in connection with questions of descriptiveness or registrability. Sometimes he did so upon reconsideration, on his own initiative, and on other occasions he was compelled to do so by a mandate of an appellate tribunal. Suffice it to refer here to the recent case *In re National Recreation Ass'n., Inc.*, 181 F. 2d 221 (1950), in which the name "Playground" had been registered for a magazine under the Act of 1905, but upon lapsing was refused registration under the same Act on the ground that, under an Appellate Court decision which had meanwhile been rendered regarding the issue of descriptiveness (*McGraw Hill Pub. Co., Inc.* v. *American Aviation Associates, Inc.*, 73 App. D. C. 131, 117 F. 2d 293 (1940) involving the word "Aviation"), the word "Playground" should now be held to be descriptive and unregistrable under the Act of 1905. It remains for the petitioner in this case to characterize such change in administrative practice as "discrimination" and a "violation of the Fifth Amendment of the Constitution". This novel allegation is, we believe, sufficiently refuted by the fact that all tribunals below were unanimous in the conclusion that the issue of a few unduly liberal and incorrect trade-mark registrations did not create a "right" in any subsequent applicant to insist upon the continuation of the initial error.

III. Petitioner reiterates before this Court the contention that it was a "clear error of law" to hold respondent, Botany Mills, Inc., entitled to institute the opposition pro-

ceedings in the Patent Office since, in petitioner's opinion, Botany had failed to make any proper showing of injury or damage. It is said in this regard (Petition for Certiorari, p. 14) that respondent Botany Mills, Inc., had no right to oppose petitioner's applications "since it had and claimed to have no prior rights or rights of any kind to petitioner's trade-mark 'LANOLIN PLUS'." It is, of course, well settled, at least since the decisions of the Court of Customs and Patent Appeals in *United Shoe Machinery Corp.* v. *Compo Shoe Machinery Corp.*, 56 F. 2d 292 (1932) and *Model Brassiere Co.*, v. *Bromley-Shepard Co., Inc.*, 49 F. 2d 482 (1931), that someone who objects to a trade-mark registration on the basis of descriptiveness, is entitled to file opposition proceedings on the ground that his right freely to use such descriptive term would be hampered if a registration were to issue to a competitor.

Conclusion

The decision of the two courts below, as well as those by the Patent Office tribunals, are correct. No question of constitutional law or statutory construction is involved. The petition for a writ of certiorari should be denied.

Respectfully submitted,

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